

RECEIVED  
CENTRAL FAX CENTER

OCT 28 2009

SPECIAL PROCESSING SUBMISSION

Docket No. 1210/69014-A/GJG/BJA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Kiran K. Chada et al.  
Serial No.: 10/630,423 Examiner: G. Chandra  
Filed : July 29, 2003 Art Unit: 1646  
For : A METHOD OF IDENTIFYING ADIPOCYTE SPECIFIC GENES,  
THE GENES IDENTIFIED, AND THEIR USES

30 Rockefeller Plaza, 20<sup>th</sup> Fl.  
New York, NY 10112  
October 28, 2009

BY FACSIMILE

1-571-273-8300

Commissioner for Patents,  
P.O. Box 1450, Alexandria, VA 22313-1450  
Sir:

PETITION REGARDING COMMUNICATION IN RESPONSE TO MAY 29, 2009  
NOTICE OF  
NON-COMPLIANT AMENDMENT (37 C.F.R. §1.121) FILED BY APPLICANTS  
ON JUNE 25, 2009

This Petition is being submitted in connection with the above-identified application and regards a Communication In Response to May 29, 2009 Notice of Non-Compliant Amendment (37 C.F.R. §1.121) filed by applicants on June 25, 2009.

Background

A Notice Of Non-Compliant Amendment (37 CFR 1.121) was issued by the United States Patent and Trademark Office in connection with the above-identified application on May 29, 2009. A response to the May 29, 2009 Notice was due on June 29, 2009. Applicants filed a Communication In Response to May 29, 2009 Notice of Non-Compliant Amendment (37 C.F.R. §1.121) on June 25, 2009 by mail using the Certificate of Mailing procedure in

RECEIVED  
CENTRAL FAX CENTER

OCT 28 2009

Applicants: Kiran K. Chada et al.  
Serial No.: 10/630,423  
Filed : July 29, 2003  
Page 2 of 5 of PETITION REGARDING COMMUNICATION IN RESPONSE TO  
5/29/2009 NOTICE

accordance with 37 C.F.R. §1.8(a). Accordingly, applicants timely responded to the Notice. A true copy of the Communication is attached hereto as **Exhibit 1**.

However, during a check of the status of the above-identified application on October 26, 2009, applicants noted that they had not received a stamped return postcard from the U.S. Patent and Trademark Office ("the Office"). In addition, applicants checked public PAIR and noted that there was no scanned image file wrapper record or transaction history record of the Communication filed by applicants on June 25, 2009.

Certificate of Mailing - 37 C.F.R. §1.8

Applicants note that, according to 37 C.F.R. §1.8(b):

"In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed or decided with prejudice, or the prosecution of a reexamination proceeding is terminated pursuant to § 1.550(d) or § 1.957(b) or limited pursuant to § 1.957(c), or a requester paper is refused consideration pursuant to § 1.957(a), the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or

Applicants: Kiran K. Chada et al.  
Serial No.: 10/630,423  
Filed : July 29, 2003  
Page 3 of 5 of PETITION REGARDING COMMUNICATION IN RESPONSE TO  
5/29/2009 NOTICE

transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement that attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing, transmission or submission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement. If the correspondence was transmitted via the Office electronic filing system, a copy of an acknowledgment receipt generated by the Office electronic filing system confirming submission may be used to support this statement.

#### Relief Requested

In accordance with 37 C.F.R. §1.8(b)(1), the undersigned hereby notifies the Office of (A) the timely mailing by Certificate of Mailing procedure in accordance with 37 C.F.R. §1.8 on June 25, 2009 of their Communication In Response to May 29, 2009 Notice of Non-Compliant Amendment (37 C.F.R. §1.121), a true copy of which is attached hereto as Exhibit 1, and (B) our recent discovery of the apparent non-receipt of the June 25, 2009 Communication by the Office.

In accordance with 37 C.F.R. §1.8(b)(2), the undersigned has supplied, as Exhibit 1 herewith, an "an additional copy of the

RECEIVED  
CENTRAL FAX CENTER

OCT 28 2009

Applicants: Kiran K. Chada et al.  
Serial No.: 10/630,423  
Filed : July 29, 2003  
Page 4 of 5 of PETITION REGARDING COMMUNICATION IN RESPONSE TO  
5/29/2009 NOTICE

previously mailed or transmitted correspondence and  
certificate".

In accordance with 37 C.F.R. §1.8(b)(3), the undersigned hereby  
attests to the previous timely mailing of the June 25, 2009  
Communication In Response to May 29, 2009 Notice of Non-  
Compliant Amendment (37 C.F.R. §1.121), a true copy of which is  
attached hereto as **Exhibit 1**. Specifically, the signed  
Communication was placed in an envelope prepared by a secretary  
of the firm addressed "Mail Stop Amendment, Commissioner of  
Patents, P.O. Box 1450, Alexandria, VA 22313-1450". The sealed  
envelope was given to a mail room staff member who franked the  
envelope with a \$1.39 postage mark at 4:12pm on June 25, 2009  
(See **Exhibit 2**). The envelope was then delivered by the same  
mail room staff member to the Rockefeller Center Post Office  
before 7pm and mailed as addressed.

Accordingly, applicants respectfully request that this Petition  
be granted and that their Communication in Response to May 29,  
2009 Notice of Non-Compliant Amendment (37 C.F.R. §1.121) filed  
on June 25, 2009 be considered timely filed.

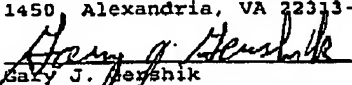
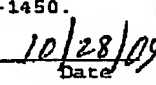
Alternatively, if this Petition is denied, applicants hereby  
request that the attached Communication In Response to May 29,  
2009 Notice of Non-Compliant Amendment (37 C.F.R. §1.121) filed  
on June 25, 2009 (**Exhibit 1**) be considered as applicants'  
response to the May 29, 2009 Notice and that a petition for a  
four-month extension of time be granted to applicants with the  
necessary fee charged to Deposit Account Number 03-3125.

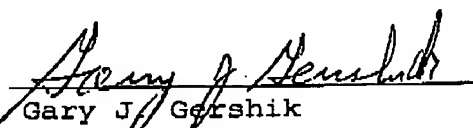
Applicants: Kiran K. Chada et al.  
Serial No.: 10/630,423  
Filed : July 29, 2003  
Page 5 of 5 of PETITION REGARDING COMMUNICATION IN RESPONSE TO  
5/29/2009 NOTICE

If a telephone interview would be of assistance in advancing prosecution of the subject application, the undersigned attorney invites the Examiner to telephone him at the telephone number provided below.

No fee is believed to be due in connection with this Petition. If any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account Number 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being transmitted by facsimile this date:	
1-571-273-8300	
Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450.	
 Gary J. Gershik Reg. No. 39,992	 Date 10/28/09

  
Gary J. Gershik  
Registration No. 39,992  
Attorney for Applicants  
Cooper & Dunham LLP  
30 Rockefeller Plaza,  
20<sup>th</sup> Floor  
New York, NY 10112  
(212) 278-0400

## EXHIBIT 1

Docket No. 1210/69014-A/GJG/BJA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Kiran K. Chada et al.  
Serial No.: 10/630,423 Examiner: G. Chandra  
Filed : July 29, 2003 Art Unit: 1646  
For : A METHOD OF IDENTIFYING ADIPOCYTE SPECIFIC GENES,  
THE GENES IDENTIFIED, AND THEIR USES

30 Rockefeller Plaza, 20<sup>th</sup> Fl.  
New York, NY 10112  
June 25, 2009

Mail Stop Amendment  
Commissioner for Patents  
P.O. BOX 1450  
Alexandria, VA 22313-1450

Sir:

COMMUNICATION IN RESPONSE TO MAY 29, 2009 NOTICE OF  
NON-COMPLIANT AMENDMENT (37 CFR 1.121)

This Communication is being submitted in response to the May 29, 2009 Notice of Non-Compliant Amendment (37 CFR 1.121) issued by the United States Patent and Trademark Office in connection with the above-identified application. A response to the May 29, 2009 Notice is due on June 29, 2009. Accordingly, this Communication is being timely filed.

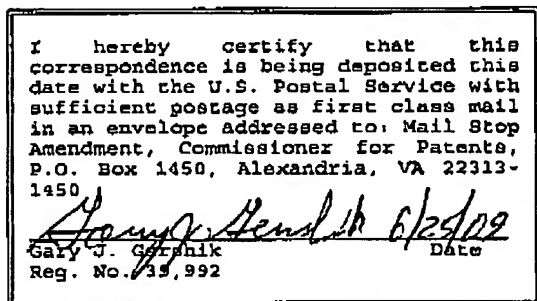
The Notice states that the Amendment filed on March 9, 2009 (actually filed March 3, 2009) does not comply because a complete listing of all the claims is not present. Specifically, the status of claims 17-46 is missing from the claim listing. In addition, the May 29, 2009 Notice indicates that claim 101 does not have the proper status identifier. A copy of the Notice is attached hereto as **Exhibit A**. In response, applicants note that claims 17-46 and 101 should be annotated as "Canceled". Accordingly, applicants attach hereto as **Exhibit B** a corrected listing of all of the claims.

Applicants: Kiran K. Chada et al.  
Serial No.: 10/630,423  
Filed : July 29, 2003  
Page 2 of 2 of Communication in Response to 5/29/09 Office Action

If a telephone interview would be of assistance in advancing prosecution of the subject application, the undersigned attorney invites the Examiner to telephone him at the telephone number provided below.

No fee is believed to be due in connection with this Communication. If any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account Number 03-3125.

Respectfully submitted,



*Gary J. Gershik*  
Gary J. Gershik  
Registration No. 39,992  
Attorney for Applicants  
Cooper & Dunham LLP  
30 Rockefeller Plaza,  
20<sup>th</sup> Floor  
New York, NY 10112  
(212) 278-0400



## EXHIBIT A

<b>Notice of Non-Compliant Amendment (37 CFR 1.121)</b>	Application No.	Applicant(s)	
	10/630,423	CHADA ET AL.	
	Examiner	Art Unit	
	Anne Marie S. Wehbe	1633	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

The amendment document filed on 09 March 2009 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

☐ 1. Amendments to the specification:

☐ A. Amended paragraph(s) do not include markings. *NON-Compliant Amend 6-29-09*  
☐ B. New paragraph(s) should not be underlined.  
☐ C. Other \_\_\_\_\_.

☐ 2. Abstract:

☐ A. Not presented on a separate sheet. 37 CFR 1.72.  
☐ B. Other \_\_\_\_\_.

☐ 3. Amendments to the drawings:

☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).  
☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.  
☐ C. Other \_\_\_\_\_.

☒ 4. Amendments to the claims:

☒ A. A complete listing of all of the claims is not present.  
☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)  
☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).  
☐ D. The claims of this amendment paper have not been presented in ascending numerical order.  
☒ E. Other: See Continuation Sheet.

☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

**TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:**

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.

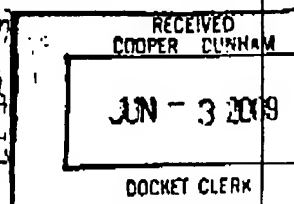
2. Applicant is given **one month, or thirty (30) days, whichever is longer**, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a Quayle action. If any of above boxes 1. to 4. are checked, the correction required is only the corrected section of the non-compliant amendment in compliance with 37 CFR 1.121.

**Extensions of time** are available under 37 CFR 1.136(a) **only** if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action.

**Failure to timely respond** to this notice will result in:

**Abandonment** of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action; or  
**Non-entry** of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

/Anne Marie S. Wehbe/ Primary Examiner, Art Unit 1633	
--	--

U.S. Patent and Trademark Office  
PTOL-324 (01-06)

Notice of Non-Compliant Amendment (37 CFR 1.121)

Part of Paper No. 20090528

Continuation Sheet (PTOL-324)

Application No. 10/830,423

Continuation of 4(e) Other: The status of claims 17-46 is missing from the claim listing. Further, the amendment includes the text of claim 101 with the status identifier (withdrawn)-however claim 101 was canceled in the preliminary amendment of 7/29/03. Claim 101 should be listed as (canceled) with no text.



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,423	07/29/2003	Kiran K. Chada	69014-A/QJG	1805
23432 7590 05/29/2009 <b>COOPER &amp; DUNHAM, LLP</b> 30 Rockefeller Plaza 20th Floor NEW YORK, NY 10112				
			EXAMINER	
			WEHBE, ANNE MARIE SABRINA	
			ART UNIT	PAPER NUMBER
			1633	
			MAIL DATE	DELIVERY MODE
			05/29/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

## **EXHIBIT B**

Listing of Claims:

1. (Currently Amended) A method of identifying genes that are over-expressed in adipocytes of white adipose tissue (WAT) from a first animal as compared to preadipocytes in WAT ~~non-adipose tissue from a second animal~~ comprising performing differential gene expression analysis between the ~~white adipose tissue [([)]WAT[([)]]~~ ~~or stromal-vascular tissue (SVT) of the first animal~~ and the WAT of the second animal wherein ~~the animals are any two different mice selected from the group consisting of wild-type, a HMGI-C -/- genotype mouse, ob/ob, and a HMGI-C -/- ob/ob genotype mouse mice.~~
2. (Canceled).
3. (Canceled).
4. (Withdrawn) The method of claim 1, wherein the differential gene expression analysis is performed between the WAT of wild-type mice and the WAT of HMGI-C -/- mice.
5. (Canceled).
6. (Withdrawn) The method of claim 1, wherein the differential gene expression analysis is performed between the WAT of ob/ob mice and the WAT of HMGI-C -/- mice.
7. (Withdrawn) The method of claim 1, wherein the differential gene expression analysis is performed between the WAT of wild-type mice and the SVT of wild-

type mice.

8. (Currently Amended) The method of claim 1 ~~any one of claims 1-7~~ wherein the differential gene expression analysis is performed using an Affymetrix GeneChip® system.
9. (Original) The method of claim 8, wherein the Affymetrix GeneChip® system utilizes the MG-U74 chip.
10. (Withdrawn) A nucleotide sequence identified by the method of any one of claims 1-9.
11. (Withdrawn) The nucleotide sequence of claim 10 having the sequence set forth in any one of SEQ.ID.NO. 1-279.
12. (Withdrawn) An isolated polynucleotide comprising
  - a) a nucleotide sequence of any one of SEQ ID NOs: 86, 87, 93, 96, 115, 116, 117, 135, 145, 148, 151, 160, 172, 179, 180, 191, 192, 201, 223, 224, 229, 236, 246, 255, 256, 263, 264, 267, 268, 276 or 277, or any one of SEQ ID NOs: 84, 85, 88, 97, 98, 99, 100, 105, 106, 107, 108, 109, 110, 111, 112, 115, 116, 117, 122, 123, 124, 125, 128, 129, 130, 131, 132, 133, 138, 139, 149, 150, 175, 176, 177, 178, 181, 182, 183, 184, 187, 188, 189, 190, 199, 200, 210, 211, 214, 215, 216, 217, 218, 219, 220, 221, 222, 227, 228, 232, 233, 239, 240, 241, 242, 243, 244, 245, 247, 248, 249, 250, 251, 252, 253, 254, 255, 256, 259, 260, 261, 262, 268, 272 or 273;
  - b) a nucleotide sequence coding for the same polypeptide as that encoded by the nucleic acid of part a);
  - c) a nucleotide sequence that has at least 90% identity over the entire coding region to the nucleotide

sequence of part a); or

c) a nucleotide sequence complementary to the isolated nucleic acid molecule.

13. (Withdrawn) The isolated polynucleotide of claim 12 comprising the nucleotide sequence of any one of SEQ ID NOs: 86, 87, 93, 96, 115, 116, 117, 135, 145, 148, 151, 160, 172, 179, 180, 191, 192, 201, 223, 224, 229, 236, 246, 255, 256, 263, 264, 267, 268, 276 or 277.
14. (Withdrawn) The isolated polynucleotide of claim 12 or 13 comprising the nucleotide sequence of any one of SEQ ID NOs: 84, 85, 88, 97, 98, 99, 100, 105, 106, 107, 108, 109, 110, 111, 112, 115, 116, 117, 122, 123, 124, 125, 128, 129, 130, 131, 132, 133, 138, 139, 149, 150, 175, 176, 177, 178, 181, 182, 183, 184, 187, 188, 189, 190, 199, 200, 210, 211, 214, 215, 216, 217, 218, 219, 220, 221, 222, 227, 228, 232, 233, 239, 240, 241, 242, 243, 244, 245, 247, 248, 249, 250, 251, 252, 253, 254, 255, 256, 259, 260, 261, 262, 268, 272 or 273.
15. (Withdrawn) An isolated polynucleotide of claim 12 comprising a nucleotide sequence coding for the same polypeptide as that encoded by any one of SEQ ID NOs: 86, 87, 93, 96, 115, 116, 117, 135, 145, 148, 151, 160, 172, 179, 180, 191, 192, 201, 223, 224, 229, 236, 246, 255, 256, 263, 264, 267, 268, 276 or 277, or any one of SEQ ID NOs: 84, 85, 88, 97, 98, 99, 100, 105, 106, 107, 108, 109, 110, 111, 112, 115, 116, 117, 122, 123, 124, 125, 128, 129, 130, 131, 132, 133, 138, 139, 149, 150, 175, 176, 177, 178, 181, 182, 183, 184, 187, 188, 189, 190, 199, 200, 210, 211, 214, 215, 216, 217, 218, 219, 220, 221, 222, 227, 228, 232, 233, 239, 240, 241, 242, 243, 244, 245, 247, 248, 249, 250, 251, 252, 253, 254,



255, 256, 259, 260, 261, 262, 268, 272 or 273.

16-46. (Canceled)

47. (Withdrawn) An isolated polynucleotide comprising
- a) a nucleotide sequence of SEQ ID NO:103;
  - b) a nucleotide sequence coding for the polypeptide of SEQ.ID.NO. 603;
  - c) a nucleotide sequence that has at least 91% identity over its entire length to a nucleotide sequence encoding the sFRP-5 polypeptide of SEQ ID NO:603 said identity being over the entire region encoding SEQ ID NO:603; or
  - d) a nucleotide sequence complementary to the isolated nucleic acid molecule.

48-101. (Canceled)

102. (Withdrawn) A bioassay for identifying compounds which prevent adipose accumulation, the bioassay comprising:
- (a) exposing a eukaryotic cell that expresses a heterologous npr3 receptor to at least one compound whose ability to modulate the activity of the receptor is sought to be determined; and thereafter
  - (b) monitoring the cells for changes in activity, wherein change in activity identify a compound as a modulator of human npr3 receptor.
103. (Withdrawn) A method for screening for compounds that modulate a target protein, wherein the target protein is npr3 and comprises a sequence that has greater than 90% amino acid identity to SEQ ID NO:778 as measured using a sequence comparison algorithm, the method comprising the steps of

a) contacting the target protein with a candidate agent at a first concentration and determining a level of activity of the target protein; and  
b) contacting the target protein with a candidate agent at a second concentration and determining a level of activity of the target protein; wherein a difference between the level of activity of the target protein contacted with the first concentration of the candidate agent and the level of activity of the target protein contacted with the second concentration of the candidate agent indicates that the candidate agent modulates the activity of the target protein.

104-115. (Canceled)

116. (Withdrawn) A compound identified by the method of any one of claims 102-115.

## EXHIBIT 2



Generated

Tuesday, October 27, 2009

at 3:58:21PM

## Disbursement By Account Detail

Client='1210'

Starting Date: 6/25/2009 Ending Date: 6/25/2009 Number of Days: 1

Date	Time	User Code	User	Count	Amount
Location: NYC:New York City					
Client: 1210:HMGene, Inc.					
Matter: 06901401:METHOD OF IDENTIFYING ADIPOCYTE SPECIFIC					
6/25/2009	4:12:22PM	323	Ryan Hinds	1.00	\$1.39
Description:				1.00	\$1.39
Totals for Matter: 06901401					
Totals for Client: 1210				1.00	\$1.39
Totals for Location:NYC				1.00	\$1.39